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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 10/072,429

Appeal 2007-2403

In re Application of:

Confirmation No.: 2615

Jacques FAGOT et al.

On Appeal From:
Group Art Unit: 3711

Filed: February 7, 2002

Examiner: Stephen Luther Blau

For: SET OF GOLF CLUBS

REQUEST FOR REHEARING

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Appeal 2007-2403
S. N. 10/072,429REQUEST FOR REHEARING

In accordance with 37 CFR §41.52, appellants hereby exercise their rights requesting rehearing of this Honorable Board's April 25, 2008 Decision on Appeal in the above-identified application.

I. REQUEST FOR REHEARING OF THE
REJECTION UNDER 37 CFR §41.50(b)

The Board's decision, page 9, stated, for the first time, the following rejection:

Claim 11 is rejected under 35 U.S.C. §112, second paragraph, as indefinite. It is unclear whether the claim expression "volume of all recesses decreases" means the volume of each and every recess on the long irons is smaller than the recess on the short irons or all the recesses taken collectively result in a decreasing volume from the long irons to the short irons.

Claim 11, whose words are still identical to the words of claim 11 as originally filed in this application, states:

11. The set of golf clubs as claimed in claim 1, wherein the volume of all the recesses decreases from the long irons to the short irons.

The U.S. Court of Appeals for the Federal Circuit has repeatedly said that claims must be construed in view of the application or patent specification in which they appear. Phillips v. AWH Corp., 415 F.3d, 1303, 1314 (Fed. Cir. 2005) (en banc); Vitronics Corp. v. Conceptronics Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996); and Markman v. Westview Instruments Inc., 52 F.3d 967 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996). As the Federal Circuit, en banc, restated in Phillips, 415 F. 3d at 1315:

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[C]laims “must be read in view of the specification, of which they are a part.” Id., [Markman, 52 F.3d] at 979. As we stated in Vitronics, the specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive, it is the single best guide to the meaning of a disputed term.” 90 F.3d at 1582.

In the present application, appellants’ specification states in relevant part:

... the volume of all the recesses may increase or decrease with the club number. In other words, the total volume of the recesses varies between long irons and short irons.

S.N. 10/072,429, specification, page 6, lines 5-9; emphasis added here. It is clear that the claim 11 words “volume of all recesses” means “the total volume of the recesses.” Or, in the language of page 9 of the Board’s April 25, 2008 decision, those claim 11 words mean the volume of “all the recesses taken collectively.” Also see the comparison discussed in the specification, page 12, lines 16-25.

Because the language of claim 11 is clear in view of appellants’ specification, appellants respectfully request reversal of the rejection of claim 11 under 35 USC §112, paragraph two.

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**II. REQUEST FOR REHEARING OF THE
AFFIRMANCE OF THE REJECTIONS UNDER
35 U.S.C. §103(a) OF CLAIMS 1, 7, 8, 12, 15 AND 16**

The Board's April 25, 2008 Decision on Appeal misapprehended and overlooked at least the following three points (1.-3. below):

1. The Board's 4/25/08 decision misapprehended and overlooked that appellants' claim 1 elements/limitations:

... wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set,

are not disclosed in any prior art evidence in this record.

Appellants' Brief on Appeal, page 6, pointed out that the PTO Examiner admitted that Peters U.S. Patent 6,093,112 did not disclose a set of golf clubs wherein each iron of the set had at least one recess opening onto a rear face of the upper wall. And at page 7 of that brief, appellants also made the point that Peters nowhere suggests varying the configuration of the upper wall of each of the club heads in a set. Significantly, nothing in the Board's 4/25/08 decision in any way disagrees with those facts.

Furthermore, the Board's 4/25/08 decision, page 7, lines 16-17, expressly states: "Appellant argues that Besnard does not vary recess volume among clubs in a set. We agree that Besnard is not concerned with a set."

Thus, the admitted facts in this appeal are that neither Peters nor Besnard discloses "a set of golf club irons, each iron of said set having a head. . . wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set," as expressly recited in appellants' independent claim 1. These elements/limitations are nowhere disclosed in the cited prior art evidence in this record.

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The fact that the prior art nowhere discloses that "volume of said at least one recess inside said upper wall varies from one iron to another within said set," is an important difference between appellants' claimed invention and the prior art. Cf., 35 U.S.C. §103(a); KSR International Co. v. Teleflex Inc., 550 U.S. ___, 127 S.Ct. 1727 (2007); Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966).

Appellants' application discloses and claims a unique addition to the prior sum of useful knowledge. "Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of ... useful Arts.'" Graham v. John Deere Co., 383 U.S. at 6. Appellants' claimed set of clubs does not remove existent knowledge from the public domain. See, *id.* Appellants disclose and claim a set of golf clubs of a previously unknown set structure.

2. The Board's 4/25/08 decision misapprehended and overlooked that the U.S. Supreme Court decisions cited in that Board decision, namely, KSR, Deere, and the Supreme Court precedents cited in KSR, are all cases wherein the prior art evidence disclosed all elements/limitations of the patent claims in issue.

The Board's decision cites and relies heavily upon the U.S. Supreme Court opinion in KSR, which was handed down after prosecution of the application here on appeal and after the submission of all briefs on this appeal. KSR cites Graham v. John Deere Co. and a number of other Supreme Court precedents. However, the Board's 4/25/08 decision overlooks the fact that in KSR and in all of the other Supreme Court precedents cited in KSR holding patent claims invalid for obviousness, every element or limitation of the asserted patent claims was found to have been present in the prior art evidence of record in such case. We note, for example, the following Supreme Court precedents cited in KSR:

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Hotchkiss v. Greenwood, 11 How. (52 U.S.) 248 (1851) -- substitution of known clay compositions for knob portion of door knob structure, not patentable.

A.&P. Tea Co. v. Supermarket Corp., 340 U.S. 147 (1950) -- a grocery checker's stand having an open bottom frame on counter with guide for guiding the frame, held not patentable.

Graham v. John Deere Co., 383 U.S. 1 (1966) -- plow shank including a spring-loaded hinge, held unpatentably obvious over prior art which included all such elements.

Calmar, Inc. v. Cook Chemical Co., and Colgate-Palmolive Co. v. Cook Chemical Co., 383 U.S. 26 (1966) -- prior art finger sprayer with hold-down lid including space or rib for seal, held unpatentably obvious.

Anderson's-Black Rock v. Pavement Co., 396 U.S. 57 (1969) -- prior art radiant heat burner mounted on prior art paving machine chassis, held unpatentably obvious.

Sakraida v. Ag Pro Inc., 425 U.S. 273 (1976) -- dairy barn cleaning system with known slope-floor dairy barn, drains, water storage tank and flush dam to release surge of water to clean barn, held unpatentably obvious.

KSR International Co. v. Teleflex Inc., 550 U.S. ___, 127 S. Ct. 1727 (2007) -- known pivoted automobile accelerator pedal attached to rotate electronic

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control (connected to carburetor/fuel injector), held unpatentably obvious.

The statute, 35 U.S.C. §103(a), requires consideration of the patentability of claims as a whole. No limitations of a claim may be ignored, In re Wilson, 424 F.2d 1382 (CCPA 1970). In such a consideration, disclosure or suggestion of all claim limitations must be present in the prior art evidence of record, to one of ordinary skill in the relevant art. That is what the statute, KSR, and its Supreme Court precedents require. And the Federal Circuit has long followed that same rule of law. See, e.g., CFMT Inc. v. Yieldings International Corp., 349 F.3d 1383, 68 USPQ2d 1940, 1947 (Fed. Cir. 2003); In re Gulack, 703 F.2d 1381, 1385 n.9, 217 USPQ 401 (Fed. Cir. 1983) (examiner concluded no combination of prior art, even if supported by motivation to combine, disclosed all limitations of claims; in light of all limitations of claims, no obviousness); and In re Royka, 490 F.2d 981, 985, 180 USPQ 580 (CCPA 1974) (obviousness requires a suggestion of all limitations in a claim).

Absent a disclosure or suggestion of every claim limitation in the prior art evidence of record, a patent claim should not be found unpatentably obvious under §103(a). In the present record, there is no suggestion of varying volume of a recess in an upper wall from one club head to another within a set. Appellants' claims should be held nonobvious and patentable.

Appellants' claimed invention is a set of golf clubs whose set structure never before existed. Appellants' claimed invention includes the elements/limitations that the volume of recess(es) in the upper wall vary from one iron to another within the set. The prior art evidence in the present record does not disclose or suggest varying the volume of recess(es) in the upper wall from one club head to another within a set. And

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appellants' claimed invention is not merely a combination or predictable variation of prior art elements, because the aforementioned elements were not known in the prior art.

Having not found the aforementioned elements/limitations of appellants' claims in the prior art, the Examiner, and now this Board, have improperly sought to use appellants' own disclosure as a roadmap through the prior art for attempted hindsight reconstruction of appellants' claimed invention, contrary to the Supreme Court's admonition to guard against use of hindsight and "to resist the temptation to read into the prior art the teachings of the invention in issue." Calmar, 383 U.S. at 36.

3. The Board's 4/25/08 decision also misapprehends and overlooks that Besnard is not:

... suggestive of three ways to move the center of gravity upwardly in the club head by increasing mass in the upper wall. One, the number of recesses might be reduced with each recess being of the same volume. Two, the volume of each recess might be reduced keeping the number of recess constant. And three, both the number and volume of the recesses might be reduced to vary the volume of material in the upper wall.

[Decision 4/25/08, page 8, lines 17-23].

The 4/25/08 decision cites no bases in the Besnard reference itself for the Board's "three ways." See, Decision, 4/25/08, page 8, lines 17-23. First, Besnard does not disclose "increasing mass in the upper wall" at all. Nor does Besnard disclose reducing the number of recesses in the upper wall with each recess being of the same volume. Indeed, Besnard nowhere suggests that each of multiple recesses would be of the same volume. To the contrary, Besnard's disclosure is that one or more recesses in a single club head have volume(s) that increase in the direction of the toe thereby providing

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gradual lightening of the upper portion of the peripheral edge towards the toe. Besnard, col. 2, lines 27-36. Second, Besnard nowhere discusses keeping the number of recesses constant and reducing the volume of each recess in an individual club head. Third, Besnard nowhere discusses reducing both the number and volume of recesses in the upper wall.

The Board's decision cites a short discussion in KSR, 127 S.Ct. at 1742, concerning trying known options among a finite number of identified, predictable solutions to a design need or problem. The Court's words "known" and "identified" meant solutions disclosed in the prior art, not solutions first disclosed in appellants' application and claims. Compare appellants' claims 11 and 12, for example, to the Board's above-discussed "three ways" which are not disclosed in Besnard. And, there is no evidence demonstrating that this record contains any indication of the number of possible ways of redistributing club head material thereby moving the center of gravity in a golf club head. Ways to redistribute club head material are legion, not merely finite in number. Still, nothing in the prior art in this record suggests varying the volume of recesses in the upper wall of different club heads in a set.

Page 8, lines 17-23 of the 4/25/08 decision are assumptions and speculations, all rooted in hindsight from appellants' disclosure, and without basis in the Besnard reference itself. As the 4/25/08 decision, page 9, itself states; "Rejections under 35 U.S.C. §103 should not be based on speculations and assumptions. In re Steele, 305 F.2d 859, 862 (CCPA 1962); Ex parte Head, 214 USPQ 550, 551 (Bd. App. 1981)."

Speculations and assumptions about the meaning of statements in a prior art reference are just as inappropriate as speculations and assumptions about the meaning of a claim whose patentability is being evaluated. Such hindsight speculation and assumptions are improper in any patentability evaluation under §103(a).

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S. N. 10/072,429CONCLUSION

Appellants' application discloses and claims a unique addition to the prior sum of useful knowledge. Appellants' claimed set of clubs does not remove existent knowledge from the public domain. Appellants not only disclose a set of golf clubs wherein each club head has one or more recesses in the upper wall (as in a set of club heads each having identical recesses in the upper wall), but a set wherein the volume of the recess(es) varies from one club head to another within the set, that is, the volume of the recess(es) in the upper wall of each club head in the set is different from the volume of the recess(es) in other club heads in the set. These elements/limitations are nowhere disclosed or suggested in the prior art in this record. And appellants' claimed invention is not merely a combination or predictable variation of prior art elements because the aforementioned elements were not known in the prior art. Those differences over the prior art provide a set of golf clubs of previously unknown set structure. Appellants' disclosure adds to the sum of useful knowledge that existed before appellants' invention. Appellants' claimed set of golf clubs did not exist before appellants' invention thereof.

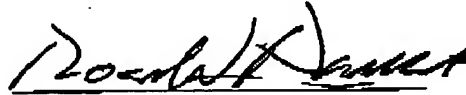
For all of the foregoing reasons, the subject matter of appellants' claims 1, 7, 8, 12, 15 and 16 (and 11 as well) are nonobvious and patentably distinct from the prior art

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evidence in this record. Therefore, appellants respectfully request rehearing of this appeal, reversal of all rejections of claims under §103(a), and allowance of all claims 1, 7, 8, 11, 12, 15 and 16.

Respectfully submitted,

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